IN THE

Supreme Court of the United States.

OCTOBER TERM, A. D. 1896.

HENRY PRATT and JOHN J. RYAN,
Partners as Henry Pratt & Co.,
Plaintiffs in Error,

vs.

PARIS GAS LIGHT AND COKE COMPANY,
Defendant in Error.

Error to the Supreme Court of Illinois.

BRIEF AND ARGUMENT FOR PLAINTIFFS IN ERROR.

May it please the Court:

On January 8, 1889, plaintiffs in error, co-partners, doing business as Henry Pratt & Co., entered into an agreement with defendant in error, Paris, Gas Light and Coke Company, to furnish and set up for defendant in error an apparatus for the manufacture of water gas, according to patents issued to Pratt & Ryan, together with engine, boiler, etc., the entire work of setting up the apparatus, engine, boiler, etc., to be done by plaintiffs in error, and completed on or before March 1, 1889; and defendant in error agreed to pay for the same, within thirty days after completion and after the same should

be tested and found satisfactory to defendant in error, the sum of $4,850; contract also contains agreement that plaintiffs in error will save and keep defendant in error harmless against any suits which might be brought against it for infringements of other patents, and if any such suit is brought, to defend the same. (See contract, Rec., 5). Everything required by the terms of the contract was furnished and completed within the time stipulated and tested and found satisfactory. There is no claim that the contract was not fully performed by plaintiffs in error, but defendant in error seeks to avoid the payment of the price agreed upon for various reasons, all of which are based upon the claim made by defendant in error that the apparatus for manufacturing water gas set up by plaintiffs in error and covered by their patents is an infringement of patents owned by other parties; and having refused to pay to plaintiffs in error the contract price this suit was brought to recover the same.

The declaration is the common counts. Defendant in error pleaded: 1st, the general issue. 2d, partial failure of consideration, viz., as to all except $100; that patents of plaintiffs in error are void and an infringement of reissued Springer patent No. 10,032 and of Lowe patent No. 167,847; that plaintiffs in error have not kept defendant in error harmless against suits for infringement; that suit is pending in the United States Circuit court against defendant in error for infringement of said Springer patent. 3d, plea alleges that plaintiffs in error obtained the contract in question by means of fraud and circumvention, which consisted of the representations: first, that the patents of plaintiffs in error were not infringements of any other patents; second, that the National Gas Light and Fuel Company had commenced

suit against plaintiffs in error for infringement but had abandoned their claim and dismissed said suit and did not at the time of the making of the contract claim that patents of plaintiffs in error were infringements; third, that the National Gas Light and Fuel Company could not disturb defendant in error in their use of said apparatus; alleges that said statements were false and known by plaintiffs in error to be false when made; alleges the bringing of said suit in the United States Circuit court, and that defendant in error tendered apparatus back to plaintiffs in error, etc.; 4th plea alleges substantially same representations as third plea; that while plaintiffs in error were about to commence construction at Paris, National Gas Light and Fuel Company notified defendant in error that Pratt & Ryan apparatus was an infringement of its patents, and that thereupon defendant in error directed plaintiffs in error to abandon the contract; that plaintiffs in error then agreed that if they were permitted to proceed with their contract they would give an indemnifying bond with good security and that on this promise plaintiffs in error were permitted to proceed; 5th plea embodies substantially all the allegations contained in the preceding special pleas, excepting that it is admitted that plaintiffs in error employed counsel who filed an answer on behalf of defendant in error in the case pending in the United States Circuit court, but have done nothing further in the case.

To these four special pleas a general demurrer was filed by plaintiffs in error, which was overruled by the court, and, by leave of court, replications were filed, and upon the issues thus joined a trial was had which resulted in a verdict for defendant. A motion for a new trial being overruled and judgment entered on the ver-

dict, the case was taken to the Appellate court of Illinois by appeal, and from that court to the Supreme court of Illinois. The judgment of the Circuit court of Edgar county having been affirmed in the Supreme court of Illinois, the case is brought to this court by writ of error to the Supreme court of Illinois.

It is not contended by defendant in error that the apparatus, etc., furnished to defendant in error was not a compliance with the terms of the contract, but it is contended :

First. That the patents issued to and the apparatus constructed by plaintiffs in error in accordance with the patents are an infringement of the reissued Springer patent No. 10,032, and also of the Lowe patent No. 167,847.

Second. That in order to obtain the execution of the contract in question, plaintiffs in error represented that the apparatus was not an infringement; that no one claimed it to be an infringnment, and that no suit for infringement would be brought against defendant in error for using it; that these representations were false and known by plaintiffs in error to be false when made, and were relied on by defendant in error.

Third. Claim having been made by the National Gas Light and Fuel Company, that the apparatus constructed by plaintiffs in error was an infringement, that in order to settle the alleged fraud practiced on defendant in error in obtaining the execution of the contract, plaintiffs in error agreed to give an indemnifying bond, which they have refused to do.

ON BEHALF ON PLAINTIFFS IN ERROR WE CONTEND:

First. That the Circuit court of Edgar county, Illinois, had no jurisdiction to determine whether the patents issued to plaintiffs in error are an infringement of any other patent or patents, and that in sustaining the jurisdiction of that court in that regard an error was committed by the Supreme court of Illinois.

Second. On the trial of this cause, in the Circuit court of Edgar county, Illinois, that court, over the objections of plaintiffs in error, admitted in evidence the letters patent issued to Theodore G. Springer and numbered 10,032, together with other evidence, including expert testimony, offered for the purpose of showing that the patents owned by the plaintiffs in error are an infringement of other patents, the ground of objection as presented by the record (Rec., 49) being that the Circuit court of Edgar county had no jurisdiction of the question of infringement until that question had been passed upon by a court of the United States, and that the only evidence competent to prove an infringement in a state court is the record of a court of the United States, finding the patents of the plaintiffs in error to be an infringement of the other patents in question. The court overruled this objection and permitted witnesses to testify on the issue of infringement. (Rec., 50.)

Third. We contend that the reissue of letters patent No. 10,032, issued to Springer, are void, and that it necessaiily follows that there can be no infringement.

Fourth. We contend that the effect of the decision of the Supreme court of Illinois is to deprive the courts of the United States of their exclusive jurisdiction to de-

termine questions arising under the patent laws of the United States.

Fifth. We claim that the decision of the Supreme court of Illinois is against the validity of an authority exercised by the commissioner of patents in granting to plaintiffs in error the letters patent in accordance with which the apparatus in question was constructed.

Sixth. We contend that the apparatus constructed by plaintiffs in error is not an infringement of the other letters patent in evidence in this case.

Seventh. We contend that the effect of the decision of the Supreme court of Illinois, sustaining the jurisdiction of the Circuit court of Edgar county in this case, is to hold that a state court has a right to determine a case arising under the patent laws of the United States and is in violation of Sections 699 to 711, Chapter 12 of the Revised Statutes.

BRIEF.

I.

A state court has no jurisdiction in any case where the decision involves the construction of conflicting patents, the jurisdiction of the United States courts in such cases being exclusive.

Revised Statutes, Chap. 12, Sec. 699 to 711.

St. Paul Plow Works v. *Sterling*, 127 U. S., 376.

Kayser v. *Arnold*, 41 Hun., 275.

Hyati v. *Ingles*, 49 Supreme Court N. Y., 375.

Dudley v. *Mahew*, 3 Court, 14.

Elmer v. *Pennel*, 40 Me., 430.

Dale Tile Manfg. Co. v. *Hyati*, 125 U. S., 46.

Wood v. *Skinner*, 139 U. S., 293.

II.

Where a question of infringement of patents is involved, a state court has no right to receive the testimony of witnesses or any other evidence than the record of a finding of a federal court construing the letters patent in question in the case.

Dale Tile Manfg. Co. v. *Hyati*, *supra*.

Elmer v. *Pennel*, *supra*.

Jarecki v. *Hays*, 161 Pa., 613.

Hovey v. *Rubber Tip Pencil Co.*, 57 N. Y., 119.

Continental Store Service Co. v. *Clark*, 100 N. Y., 365.

Tomlinson v. *Battell*, 4 Abbot's Practice, 266.

Brooks v. *Stolly*, 3 McLean, 523.

Rawson v. *Hagar*, 48 Ia., 269.

Cowen v. *Mitchell*, 11 Heisk (Tenn.), 87.

ARGUMENT.

Before proceeding with the argument upon the errors assigned, we desire to say a few words upon the question of fraud raised by the pleadings and evidence in this case in the trial court, believing, as we do, that the evidence was not sufficient to warrant a finding of that issue in favor of the defendant, and, therefore, it must be presumed that the jury reached its decision upon some of the other questions involved.

"The court will not rescind a contract without the "clearest proof of the fraudulent misrepresentations and "that they were made under such circumstances as show "the contract was founded upon them."

Tuck v. *Downing*, 76 Ill., 71.
Joung v. *Young*, 113 Ill., 430.
Carter v. *Nathan*, 67 Ill., 270.
Hauk v. *Brownell*, 120 Ill., 161.
Shinn v. *Shinn*, 91 Ill., 477.

In the case last cited the court, on page 486, says: "Something more than suspicions are required to prove "fraud at law. The evidence must be clear and cogent "and must leave the mind well satisfied that the allega-"tion is true." The evidence presented upon this question does not warrant the conclusion that the jury found that any fraudulent representations were made by plaintiffs in error to induce the making of the contract. Mr. Z. E. Powell, president of the defendant, and Mr. Eads were both present at the making of the contract. Mr. Eads alone testified that Pratt, who acted on behalf of plaintiffs in error, said that no person claimed the pat-

ents of plaintiffs in error to be an infringement (Rec., 29), while the testimony of Powell strongly corroborates the version given by Pratt, who denied the version given by Eads as to what was said.

Z. E. Powell testified that Pratt stated at the time of signing the contract that defendant had a perfect right to use the apparatus and claimed there was no question about it not being an infringemet upon any other; that the patent was clear and so assured Mr. Eads. "He "said they had no right to jump onto them for an in- "fringement suit because it was not an infringement of "their patent or plan. * * * He said that they had "withdrawn a suit in Iowa." (Rec., 44.) Pratt testified as to that conversation, and we submit that his statement is more reliable than that of either of the other parties to that conversation because it is straightforward and complete and is borne out by other circumstances, trivial in themselves perhaps, but which show that his recollection of what did occur is more accurate. He says he told them the suit in Iowa had been dismissed (Rec., 113); that there had been a suit for interference in Washington in the Patent Office when he applied for his last patent; that the interference suit in Washington had been heard before the primary examiner, before the board of examiners in chief and the commissioner of patents, and that the Pratt and Ryan patents had been sustained; that he believed he had a good and valid patent which did not infringe on any other patent.

He informed these gentlemen of threats that were being made against the customers of plaintiffs in error. This fact is shown by the contract itself, which this witness testified was changed at the suggestion of Mr.

Eads so as to contain the provision (interlined) that plaintiffs in error would save and keep defendant in error harmless from suits for infringement and that they would defend said suits at their own expense. The testimony of Pratt upon this question is uncontradicted. He also testifies that no suit was pending in relation to the patents at that time so far as he knew, and stated (Rec., 114) that at the suggestion of Mr. Eads he interlined in the proposition the words: "If any such suits are brought we will defend the same at our own expense." It will be noted that the proposition made in this form was accepted by the defendant in error and constituted the contract between the parties. This testimony certainly indicates that defendant in error was fully aware that threats of litigation had been made, and that suits were likely to be brought against defendant in error, and there is no evidence in the record that the suit which was brought was not defended by plaintiffs in error, but, on the contrary, the evidence shows that counsel were employed by plaintiffs in error to defend said suit, who did defend the same.

There is no evidence in the record that the statements attributed to Pratt by the witness Eads were not true. It is not denied that the suit in Iowa had been dismissed, and it appears from the record that no other suit was pending at that time. We therefore submit that there was no satisfactory testimony to sustain the claim—that the contract was procured by fraud, and this being true there was no consideration for the alleged promise to execute a bond, and it can not, therefore, be presumed that the jury found this issue against the plaintiffs in error, and we insist that the case must have been decided upon one or more of the questions involved in the assign-

ment of errors hereinbefore referred to, and which we will now proceed to consider.

I.

AS TO THE RIGHT OF THE STATE COURT TO RECEIVE THE TESTIMONY OF WITNESSES ON THE QUESTION OF INFRINGEMENT OF PATENTS.

The Supreme court of Illinois in the opinion filed herein says: "If appellants had no right to grant the use "of such apparatus there was a total failure of considera- "tion and appellee was not bound * * * to sub- "ject itself to liability for infringement upon the Springer "patent *and might rightfully refuse further* to be "bound whenever it *became apparent* that the use of the "apparatus * * * subjected it to suit for damages "by the owners of the Springer patent." If this rule should be once established it would soon become a prolific source of dishonest and fraudulent defenses in suits brought to recover the purchase price of machinery covered by letters patent. It would be only necessary for a person purchasing the patented article which had been represented to be no infringement to get some person claiming a rival patent to bring suit for infringement against him in order to prove his right to a rescission of his contract of purchase, and all suits brought for the purchase price of a patented machine would thus meet with a complete and speedy overthrow and leave the seller wholly without remedy.

What possible difference can there be between the issue of infringement involved here and the issue involved between the *owners* of conflicting patents?

Whether the issue is raised between the owners of two separate patents or by the owner of one of the patents and a third person can not change the issue involved. The issue is precisely the same, viz: Does the machine manufactured according to the specifications set forth in one patent infringe upon the machine manufactured according to the specifications set forth in the other patent? Is this court prepared to hold as the law that where the issue of infringement is directly involved in a suit brought upon a contract that issue may be decided by a state court upon expert testimony simply because the issue is raised by a person other than the owner of the alleged conflicting patent?

How does the issue thus presented differ, so far as the state of Illinois is concerned, from a suit brought by the owner of one patent against the owner of another to test the validity of the patent? A decision proclaiming the infringement would be as effectual in driving the defeated owner of the patent out of the business of selling his machine in the state in the one case as in the other, and can it be doubted that *the question of infringement would be as directly involved in the one case as in the other?* Would not the result as between the owners of the conflicting patents be the same so far as the territorial limits of the state are concerned? If it would not, the same defense could be made in every case where a purchaser of the Pratt & Ryan machine should be made defendant in a suit to recover the purchase price and the litigation would never end during the life of the patent unless plaintiffs in error ceased to do business in the state, for as plaintiffs in error could not bring suit in the federal court to test the question, because no claim could be made by them against the owner of the Springer

patent for infringement, the latter could not be prevented from insisting that the Pratt & Ryan apparatus is an infringement of the Springer machine, and the result in each case would depend upon the whims of the men composing the jury selected to try the issue, and the state court might find itself in the anomalous position of having in one case affirmed a judgment finding the Pratt & Ryan apparatus to be an infringement of the Springer patent or machine while affirming in another case a finding and judgment of a court and jury which had determined that it was not an infringement! Thus the very purpose of the act of Congress enacted to bring about uniformity of decision and settle once for all any question of infringement of patents would be utterly defeated.

Plaintiffs in error are powerless to prevent the owners of the Springer patent from continuing to do what the record in this case shows them to have been doing, viz: Commencing suit for infringement against persons who purchased from plaintiffs in error, and, the case being called for trial after interposing every movement possible for delay, permitting it to be dismissed for want of prosecution, as the record shows was done in the Iowa case, referred to in the evidence of plaintiffs in error in this record.

The effect of the decision of the state court in this case, if permitted to stand, will be to drive plaintiffs in error out of the business of manufacturing and selling their machine in the state of Illinois, for no person becoming familiar with the decision or with the claim of infringement after purchasing would pay for any apparatus, as such purchaser would have the right to plead the alleged infringement as a defense to any claim for the purchase money after tendering back the machine even though used

by him for a period of twenty-two months, as was the case here, and by adopting the same course pursued in Illinois, the National Gas Light and Fuel Company could drive plaintiffs in error out of every state in the union, and the act of Congress which provides that the courts of the United States shall have exclusive jurisdiction of all cases arising under the patent laws would be thereby utterly defeated, and the question of infringement settled by each state for itself in entire disregard of the act of Congress passed for the protection of inventors. A chancery suit, when no cross-bill is filed, may always be dismissed by complainant, and therefore, there being no basis for a cross-bill in such a suit as those brought against the customers of plaintiffs in error by the owner of the Springer patent, it is the privilege of the latter to dismiss the bill at any time, and thus prevent a trial of the issues involved and by pursuing that course under the decision in this case deprive plaintiffs in error of the benefit of their patents.

It is admitted that the apparatus constructed by plaintiffs in error for defendant in error was constructed in accordance with the patents owned by the former and, therefore, a determination of the question of infringement required that a construction should be given to the patents involved in this controversy and we affirm that *there is not an adjudged case anywhere to be found* which holds that *a state court can try such an issue.*

THE CASES CITED BY THE SUPREME COURT OF ILLINOIS IN SUPPORT OF THE CONTENTION THAT A STATE COURT HAS A RIGHT TO HEAR AND DETERMINE THE QUESTION OF INFRINGEMENT OF PATENTS DO NOT SUPPORT THAT CONTENTION.

The following are the cases referred to:

Rice v. *Garnhart*, 34 Wis., 543.
Page v. *Dickerson*, 28 Wis., 695.
Nye v. *Raymond*, 16 Ill., 154.
Bliss v. *Negie*, 8 Mass., 46.
Slemmer's Appeal, 58 Pa., 155.
Middlebrook v. *Broadbent*, 47 N. Y., 443.

We will examine these cases in the order cited by that court.

The case of *Rice* v. *Garnhart*, 34 Wis., 453, is in line with all the other cases which hold that where the question is one relating to the novelty or usefulness of the invention the state courts have jurisdiction to try the issues raised by a plea of failure of consideration, and we do not claim that the state courts have no jurisdiction to try the issue thus raised in any event; what we do claim is that upon the issue thus raised the *state court can not undertake to decide a claim involving the construction of two different patents*, and that a decision of such a question based upon any other evidence than the record of a finding of a federal court upon the question of the infringement of the identical patents involved in the suit is error.

That this issue was not involved in the case of *Rice* v. *Garnhart* is shown by the language of the court. "There "are many adjudications which uphold the jurisdiction

" of the state courts in actions like this," says the court on page 464, and an examination of the authorities cited will show that not one of the authorities referred to by the court controverts our position that a state court could not receive the testimony of witnesses on the question of infringement.

In the case of *Rice* v. *Garnhart* the construction of two conflicting patents was not involved. The testimony offered was as to the lack of novelty of the patented article. The defendant offered to show that the same principle covered by the letters patent had been in use before the letters patent were granted, and that this was the only question touching the patent laws which was involved in that case. The right to hear the testimony of witnesses on a question of infringement of patents was not before the court, and any intimation by the court that such right exists was merely *dictum* and should be disregarded.

It is true the court dissent from the decision of the court in *Elmer* v. *Pennel*, 40 Me., 430, *but only in so far* as that case holds that in no case can a state court take jurisdiction of a case where a patent right is in any way involved.

The case of *Page* v. *Dickerson*, 28 Wis., cited by the court, is not in point, as will be seen by the language used on page 697. Referring to the ruling of the court in the case of *Elmer* v. *Pennel*, as to the jurisdiction of the state court, the court says: " But whether the doctrine " of this case is more sound and reasonable than that of " the authorities which have gone into the question of " consideration, and thus incidentally inquired into the " validity of the patent, it is not material for us to deter-

"mine on this appeal." And the same court in a case decided at the same term at which the decision was rendered in the case of *Rice* v. *Garnhart*, referring to the case of *Page* v. *Dickerson*, after saying that the case under discussion presents substantially the same question involved in that case, says that the case calls for no "decision upon the construction of the patent laws or in "respect to the validity or infringement of a patent," *Leonard* v. *Barnum*, 34 Wis., 107, and this construction given to the decision of the case of *Page* v. *Dickerson* shows conclusively that the opinion of the court was not held to apply to cases where an infringement is claimed, and as there was no offer to prove by the testimony of witnesses in the case of *Rice* v. *Garnhart* that the patent in controversy was an infringement of any other patent, the decision of the court in *Elmer* v. *Pennel* upon this question must prevail, as in the latter case the offer was made to prove an infringement in this manner.

In the case of *Nye* v. *Raymond*, 16 Ill., 153, the defendant alleged as a failnre of consideration that the plaintiff had no right to sell the patent, and that there was no patent upon the machine. To these pleas a demurrer was filed, which was overruled by the court and judgment rendered for defendant, and the error assigned was the overruling of the demurrer. No proof was offered, nor was there anything in the record which required the court to pass upon a question of infringement of patents. No question is made as to how the *validity* or *invalidity* of the patent could be shown.

If the case had proceeded to trial upon the issues and the defendant had shown by the record of the proper federal court that the patent was invalid, such defense would have been proper, and in deciding that case on de-

murrer the court simply said in effect that the defendant had a right to show by *competent* evidence that the patent was invalid, but did not say what would be competent evidence upon the trial of that issue, and therefore that decision can not control the case at bar.

In the case of *Bliss* v. *Negus* there was no claim that the patented machine in question was an infringement of any other patent. On the contrary, it was claimed that the alleged invention, as the court said in that case, "had long before the issuing of the patent been known "and practiced, as well in this country as in England, "and this was known to the patentee at the time the "letters patent issued. The letters patent were then "obtained by fraud and *false* swearing and were utterly "void."

In *Slemmer's Appeal*, 58 Pa., 155, the question was not presented; that was a bill to compel an assignment of a patent, the validity of which was not in any manner questioned, and in discussing the question of jurisdiction the court says (page 165): "A court of equity can not "decree an assignment of a patent on the ground that "the patentee is not, but the plaintiff is, the original in-"ventor, in whole or in part. Besides which, *for a* "*state court to decide directly* that A is *not the sole orig-*"*inal inventor*, but that A and B are jointly the invent-"ors, and so entitled *to the patent and to decree an* "*assignment*, or grant an injunction accordingly, would "be to usurp the jurisdiction which has been exclusively "vested, as we have seen, in the courts of the United "States." And the court declined to hold that it had the right to determine whether the process in question was the exclusive invention of the patentee, but under the prayer for general relief decreed the complainants to

be entitled to a license to use the process covered by the patent. All parties admitted the validity of the patent and no question of infringement was involved.

The recent case of *Jarecki* v. *Hays*, 161 Pa., 613, lays down the rule for which we contend. In the latter case the master, whose report and findings upon the law and facts is set out in the opinion, found among other things, as a matter of law that "until the United States courts "have declared the patent invalid, *evidence of its invalidity is not admissible in an action for the price*," citing *Elmer* v. *Pennel*, 40 Me., 430 (see bottom of page 617), and the Supreme court in affirming the case says: "We "fully concur with the learned master in his findings of "fact and *also in his conclusions of law*. His *entire* re- "port is a compact, forcible and convincing presentation "and treatment of the various matters of contention, and "any opinion we might write would be a mere *repetition* "of his *findings* and his reasoning. * * * We are "clearly of opinion that the decree of the learned court "below should be affirmed upon the findings and con- "clusions so well and lucidly expressed in the report of "the master, *and we* so hold."

In view of this opinion it seems to us that the Supreme court of Illinois is in error of finding that the Supreme court of Pennsylvania has established a different rule.

In the case of *Middlebrook* v. *Broadbent* no question arose upon conflicting patents, and the doctrine as to the admission of evidence of infringement as laid down in *Elmer* v. *Pennel*, 40 Me., 434, was approved by the New York court (page 447), where the court, commenting on the case of *Dickerson* v. *Hall*, 14 Peck., 217, says: "In

" *Elmer* v. *Pennel* defendant offered to show that the " patent was an infringement of an elder patent. Ex- " cluded; and the court upon review held it properly ex- " cluded, among other cases citing *Dickerson* v. *Hall*, " and sustaining that case upon the ground that the " patent was not useful for any beneficial purpose."

The defense set up in *Middlebrook* v. *Broadbent* was substantially the same as that set up in the case of *Dickerson* v. *Hall*, viz: not that the patent was an infringement, but that it was not useful. There was no attempt to prove an infringement of another patent.

In the case of *Hyatt* v. *Ingles*, 49 Supreme Court N. Y., 375, on page 378 the court says: " A grant to a pat- " entee of an exclusive right to manufacture and vend " an article described therein is a grant of property, and " if the validity of the patent is unquestioned, state " courts will protect the owner of such property in the " enjoyment thereof by means of a decree or injunction " to the same extent as they would do were the subject " matter of the litigation of any other description. But " where the validity of the plaintiff's patent is put in " question by the pleadings in a state court, and the de- " fendants present such proof upon the trial as to render " it necessary for the court to examine the parties upon " the conflicting patents or claims of property in an in- " vention, in order to determine whether the plaintiff has " such a property in the subject matter of the grant as " entitles him to the exclusive and unmolested use of it, " and an objection is taken to the jurisdiction of the court " for that reason, the bill must be dismissed, for in such " cases the jurisdiction is in the courts of the United " States exclusively."

We do not contend that if the patented appliance had for any considerable time been in use openly by other parties before a patent was obtained, this fact could not be shown by the testimony of witnesses, as in that case no construction of alleged conflicting patents would be required; but in the case at bar, in order to determine the question of infringement by the testimony offered, it became necessary to introduce the letters patent in evidence and give a construction to their provision, and decide, so far as this case is concerned at least, whether the commissioner of patents had exceeded the powers granted to him under the acts of Congress in issuing the letters patent to Pratt & Ryan.

The revised statutes of the United States provide that every patent shall contain " a grant to the patentee, his " heirs or assigns for the term of seventeen years of the " exclusive right to make, use and vend the discovery " throughout the United States," etc. (See Revised Statute of U. S., 1873–4; Sec. 4884.) The commissioner of patents having issued a patent in accordance with the statute, can a state court declare in any case that the officer of the government should not have issued the patent because the device was covered by a patent previously issued to Springer? Yet that is the effect of the decision in this case. Paragraph 5 of Sec. 711 of the said revised statutes provides that the courts of the United States shall have exclusive jurisdiction " of all " cases arising under the patent-right or copyright laws " of the United States."

Can it be contended that the state court has a right to determine whether a right granted under Sec. 4884, above referred to, has been properly granted? Does not the decision of that question require that the court shall

determine the issues "arising under the patent-right "* * * laws of the United States"? If so, the state court can not decide it without the nullification of the federal statute.

In Curtis on Patents (Sec. 496), referring to the acts of Congress, the author says: "The judicial interpreta- "tion of these enactments has been to the effect that the "jurisdiction thereby conferred upon the Circuit and "District courts in the first instance and to the Supreme "court on appeal, is not merely an original one, but "also an exclusive one, *so that the state* courts have no "cognizance whatever of actions in which the validity or "force of letters patent is involved." Citing

Dudley v. *Mahew*, 3 Comst., 14.
Elmer v. *Pennel*, 40 Me., 430.

The New York Court of Appeals in the case of *Waterman* v. *Shipman*, 130 N. Y., 301, says: "An infringe- "ment, as applied to patents, is a violation of the ex- "clusive right conferred upon the patentee. *An ad-* "*judication that a certain act is an infringement neces-* "*sarily requires the construction of the right by com-* "*parison of principles or processes, a determination as* "*to its nature and extent.*"

In the case of *Wood* v. *Skinner*, 139 U. S., 293, which held that no federal question was involved, the court says: "Neither the construction nor the validity of the "plaintiff's patent was regarded as material." Had it been material the court holds a federal question would have been involved, but the state court having held that in the decision of the case "it was unnecessary to determine "whether the defendant had actually made use of the "device or its equivalent and held it liable upon the

"ground that it had agreed to use it upon all its machines "and was, therefore, bound to pay its value as fixed by "the referee." And, "as the case might properly have "been determined upon a ground broad enough to sup- "port the judgment *without resort to a federal question* "this court has no jurisdiction." Thus holding that if the "construction or validity" of the patent had been involved the question would have been one of which the federal courts would have jurisdiction.

In the case of *The Dale Tile Manufacturing Co.* v. *Hyatt*, 125 U. S., 46, the question here presented was substantially decided. In that case a motion was made in the Supreme court of the United States to dismiss for want of jurisdiction, and the motion was denied. Speaking for the court, Mr. Justice GRAY said: "The defendant "contended in the courts of New York that those courts "had no jurisdiction, because the plaintiff's right to main- "tain her action depended upon whether the second re- "issue of her patent was valid or invalid under the pat- "ent laws of the United States, and that of that question "the courts of the United States had exclusive jurisdic- "tion. The judgment of each court of the state hold- "ing that the question of the validity of that reissue "could not be contested in this action, and assuming "jurisdiction to render judgment against the defendant, "necessarily involved a decision against the immunity "claimed by the defendant under the constitution and "laws of the United States, which this court has jurisdic- "tion to review." And the court holds that the only federal question involved, viz, whether the state court had the right to try the question of the validity of the reissue, was correctly decided by the New York courts.

The opinion of the New York Court of Appeals in that case, by Mr. Justice PECKHAM, now a member of this court, was fully approved by this court, and is published in connection with the opinion by Mr. Justice GRAY.

II.

THE PATENTS OF THE PLAINTIFFS IN ERROR ARE NOT AN INFRINGEMENT OF THE OTHER PATENTS MENTIONED.

If this court should decide that the evidence of witnesses upon the question of infringement was properly admitted, we insist that the defenses set up in the special pleas that the apparatus constructed by plaintiffs in error, on account of which this suit was brought, with the mode of operation, was an infringement of reissue letters patent No. 10,032 (Rec., 168), issued to Theodore G. Springer, dated February 7, 1882, and of letters patent No. 167,847, issued to T. S. C. Lowe (Rec., 174), and dated September 21, 1875, are not sustained by the record. And we claim :

First. That reissue letters patent No. 10,032 was void.

Second. That the apparatus erected by them was no infringement of either of said letters patent.

Reissue of letters patent is authorized by section 4916 of U. S. Rev. Stat., which provides for a reissue only when any patent is *inoperative* or *invalid* by reason of a *defective* or *insufficient* specification, when the error has arisen by *inadvertence, accident* or *mistake*, and without any fraudulent or deceptive intention; and the statute expressly states: "But no new matter shall be intro-

" duced into the specification, nor in case of a machine " patent shall a model or drawings be amended, except " each by the other." The rule is imperative that the fault must arise by accident, mistake or inadvertence, and without fraudulent or deceptive intention.

Coon v. *Wilson*, 113 U. S., 277.
Parker & Whipple Co. v. *Yale Clock Co.*, 123 U. S., 87.

To justify the reissue of a patent for the purpose of enlarging its claim there must be a real *bona fide* mistake inadvertently committed, such as a court of chancery in cases within its ordinary jurisdiction would correct.

Miller v. *Brass Co*, 104 U. S., 355.

By a comparison of the descriptive part of the apparatus and its operation in the specification of the original patent, with the specification of the reissue patent, it will be found that they are exactly the same. The other part of the specification relates to the alleged advantages over other apparatus, so that if the original was invalid or inoperative from a defective description of the invention, then the reissue is likewise invalid and inoperative

In the specification of the original patent it is stated that:

> " The nature of my invention consists in the construction and arrangement of an automatic machine for producing a fixed gas from petroleum, or its products, and water; and, also, storing away in the daytime a sufficient amount of heat to generate what gas is consumed through the night, as will be hereinafter more fully set forth.
>
> " In all the old processes the gas is generated during the daytime by keeping the retorts constantly at work, storing away the gas generated in a large gas-holder and consuming it at night, which requires

a very large receiver to hold the gas, and this is very expensive, and requires a great deal of room.

"In my process of storing away the heat in the day time, and making the gas at night, just as it is used, I do not require more than one-fiteenth part the room or one-twentieth part the expense in construction of my works to make the same amount of gas as by the old process. Besides, I am enabled to put in works for a single block of buildings in a city, which would not be practical by the old process, on account of room and the smell attending the storing of the gas.

"By my process I can construct works in each block in a city, and as I require no holder to store gas in, and no main pipes larger than four inches, I am enabled to light a town for one-half the cost of laying mains by the old process."

These quotations are followed by a description of the apparatus and its operation, and three claims are made for the invention described. All the claims in the original patent are retained in precisely the same words in the reissued patent, so that if any of those claims were invalid or inoperative in the original patent, such claim is still invalid or inoperative. There is no difference in the drawings.

The specification of the reissued patent contains the following statement:

"This invention relates to certain improvements in processes and apparatus for the manufacture of gas, and it has for its objects to provide certain means whereby the heat necessary to decompose the gas-producing material may be stored up and utilized for the generation of gas in quantities as required for use, as more fully hereinafter specified.

"Heretofore in the manufacture of gas the gas-producing material, consisting of solid or liquid hydrocarbons, either alone or in conjunction with

water, has been invariably subjected to decomposition in retorts or generators of limited capacity, and the gas generated has been collected and stored in a suitable holder or holders. In order, however, to store a supply of gas at all adequate to the demands, especially in large cities, very large gas-holders or a series of holders are required, which are expensive and occupy a large amount of valuable room. In the present process, by storing up the heat and generating the gas as required for use, and in quantities only to supply the demand for the time being, such holders may be dispensed with entirely, or reduced to such an extent as to serve simply as regulators or governors, in which case they will occupy comparatively little room. Hence I am enabled to put in works for a single section of a city—say a block for instance—which would not be practical under the old process, owing to the room and smell attending the storing of the gas; and the mains, where the works are distributed according to my invention, can be made much smaller than usual; it is evident that by my process and apparatus a city may be lighted at much less cost than by the old process. Again, it is well known that the gas-producing hydrocarbons can only be decomposed to produce a fixed gas at an elevated temperature, and it has heretofore been deemed necessary to employ retorts or generators of small capacity, as the only practical means by which the gas-producing material could be subjected to a heat of the required intensity, and hence the necessity of storing up the gas for use, as it was impractical under the old process to meet a continuous demand for gas for any length of time by means of the small retorts or generators in use, without large holders.

"I have discovered that by constructing a generator of such capacity that a large amount of refractory material capable of absorbing and afterwards giving off heat may be retained in mass in the generator, such material may be heated to the proper temperature and the heat stored up for future or subsequent use, in such manner that the

gas may be continuously generated in quantities to supply any required demand. Moreover, I have discovered that the loss of heat by radiation diminishes rapidly as the capacity of the generator is increased, since the cubic capacity increases in geometrical proportion, while the superficial area or radiating surface increases in arithmetical proportion. For instance, in a rectangular generator of one cubic foot capacity, the radiating surface, which would consist almost wholly of the vertical sides of the generator, would be four square feet; while a generator of ten times the superficial area—that is to say, forty square feet—the cubic capacity would be one hundred cubic feet. As the radiation is only at the outside of the generator, it is evident that by thus having a large body of material in mass a great saving of heat is effected, as the central portions of the mass radiate no heat whatever, and will retain the heat imparted to such portions a sufficient time to render it possible and practicable to store up the heat necessary for decomposing the gas-producing material effectually, in quantities as demanded.

"Another source of loss of heat heretofore experienced in cupola-generators, to which my invention is particularly applicable, has arisen from the fact that the generator, or 'superheater' as it has sometimes been denominated, has always been made entirely separate from the combustion chamber or furnace, causing loss by reason of the extended radiating surface attendant upon such construction. This objection I obviate by having the combustion chamber and generator in one structure, as more fully hereinafter specified."

Following the above is the same description as in the original patent, all the claims of the original patent (Rec., 145) and four new claims.

The drawings, specifications and claims of the original patent are in no way conflicting as to the nature of the invention intended to be secured. They all concur in

showing an automatic apparatus and nothing else is suggested; an apparatus to store heat in the daytime and operate automatically at night to make gas to supply the demand and no more; an apparatus controlled automatically so as to limit the manufacture to the immediate demand, thereby dispensing with the necessity of a holder of any considerable size, and making it possible to light a city by numerous small plants, and avoid the laying of large mains; and it is suggested that no main larger than four inches would ever be required.

What the invention intended to be secured was, is to be ascertained by consulting the original patent.

Parker Whipple Co. v. *Yale Clock Co.*, 123 U. S., 99.

There is no process, no apparatus, nor any use of an apparatus described, except an automatic one. There is nothing else suggested or indicated in the original specification or drawings, and the three original claims fully cover the process and devices described. At any rate the claims added in the reissue are not in the same line at all, and there was no attempt to amend the original claims in any way.

No reissue claim can stand upon a model alone, nor even alone upon the drawing of an original patent; neither models, drawings, nor descriptions, nor all of them together can support a reissue claim, unless the court can see from a comparison of the two patents that the original patent embodied, as the invention to be secured by it, what the claims of the reissue are intended to cover.

Walker on Patents, Sec. 233.

Hoskins v. *Fisher*, 125 U. S., 233.

Hailes v. *Stove Co.*, 123 U. S., 587.

The first claim added to the reissue patent is as follows:

> "1. The herein described process of manufacturing gas, the same consisting in the following steps, to wit, raising to incandescence a mass of carbonaceous material by a current of air, producing carbonic oxide; then burning the carbonic oxide by means of air above the bed of carbonaceous material, and causing the products to pass into a mass of refractory material for highly heating the same; then decomposing water and naphtha by the incandescent carbonaceous material producing water gas; and, finally, fixing such gas by passing it through the mass of highly heated refractory material, substantially as specified."

If this claim is given a construction to the full scope of its verbiage, then it is a claim for the manufacture of water gas, with or without the use of the automatic feeding of water and liquid hydrocarbon; it is entirely independent of whether the gas is produced as fast as used and no faster, or whether the heat is stored in the fixing chamber in the daytime and used at night or not, and of whether or not a gas holder or gas mains are dispensed with. If this claim is given this broad construction, then it is something entirely outside and beyond the scope of the original patent. It is not suggested or indicated, as a part of the invention intended to be covered by the original patent. It is not "for the same invention." On the other hand, if the construction of this claim is narrowed to come within a fair construction of being for the same invention, then it was clearly and specifically claimed with the proper limitations, in the first claim of the original patent, which is retained in the reissued patent as the fifth claim, and there was, therefore, no foundation for the reissue so far as the first claim thereof is concerned.

The next claim added to the reissue is as follows:

> " 2. The method herein described of producing gas by storing up in a mass of refractory material the heat generated and carried off by the ignited gas evolved from the burning, and while it is being prepared to decompose the liquid gas stock in mixed gases, and subsequently utilizing such heat by converting the mixed gases produced from liquid gas stock in contact with the incandescent fuel into a fixed gas, by passing such gases into and through the refractory material, substantially as described."

What do the words " subsequently utilizing such heat," as used in the above claim, mean? If they mean that the stored up heat is to be used as soon as the " burning fuel " is prepared " to decompose the liquid gas stock " without the automatic feed for the water and hydrocarbons, then there is nothing in the original patent to base such a claim upon. The original patent does not purpose to be for an invention of a process or apparatus for the manufacture of water gas, *simpliciter*, but " consists " in the construction and arrangement of an *automatic* " machine for producing a fixed gas from petroleum, or " its products and water, and, also, storing away in the " day time a sufficient amount of heat to generate what " gas is consumed through the night."

The other claims added in the reissue are as follows:

> " 3. A cupola or gas generating apparatus having a combustion and decomposing chamber for burning solid hydrocarbons, wherein water and hydrocarbon may be mutually decomposed, and a fixing chamber partly or wholly filled with some refractory material for absorbing heat, and converting the hot gases from the combustion chamber into a fixed gas, the two chambers being formed, in one struct-

ure, substantially as and for the purposes specified.

4. A cupola or gas generating apparatus having a decomposing and combustion chamber, a perforated diaphragm at the top thereof, and a fixing chamber containing refractory material above, and provided with an air supply pipe for supplying air to support combustion of gases from the lower chamber for storing heat in the fixing chamber for the purpose specified."

These two claims are based on the new matter introduced into the specification, which has been already quoted. They are meant to cover a cupola with two chambers in one shell, one for a combustion chamber and the other for a fixing chamber. The new matter above quoted states: "Another source of loss of heat "heretofore experienced in cupola generators, to which "my invention is particularly applicable, has arisen from "the fact that the generator or 'superheater,' as it has "sometimes been denominated, has always been made "entirely separate from the combustion chamber." There is nothing whatever in the original specification or claims that in the slightest degree tends to show that these two claims were then contemplated as a part of the invention intended to be secured by such original patent. If it were true that prior to the time of making the application for the original patent, cupola generators had always been made with the combustion chamber entirely separate from the fixing chamber, and if the putting of the two chambers in one structure would amount to invention, there is nothing in the original patent from which it can be inferred that it was any part of the invention intended to be secured by that original patent, and the reissue is therefore an unlawful enlargement of the original patent.

While the new description may properly contain things which are indicated in the original specifications, drawings or Patent Office model (though not sufficiently described in the original specification), it does not follow that what was indicated in the original specification, drawings or Patent Office model is to be considered as a part of the invention, unless the court can see, from a comparison of the two patents, that the original patent embodied, as the invention intended to be secured by it, what the claims of the re-issue are intended to cover.

Parker & Whipple Co. v. *Yale Clock Co.*, 123 U. S., 99.

If letters patent fully and clearly describe and claim a specific invention complete in itself, so as not to be inoperative or invalid by reason of a defective or an insufficient specification, a reissue can not be had for the purpose of expanding and generalizing the claim in order to embrace an invention not specified in the original.

Burr v. *Duryea*, 1 Wall., 531.

And in such case the court ought not to be required to explore the history of the art to ascertain what the patentee might have claimed; he is bound by his statement describing his invention.

James v. *Campbell*, 104 U. S., 357.
Helad v. *Rice*, 104 U. S., 753.

2d. That the reissue was applied for and obtained for the purpose of covering the devices shown and described in letters patent No. 234,400, dated November 16, 1880, issued to A. O. Granger and J. H. Collins, Jr. (Rec., 148.)

In the patent last mentioned, beginning at line 57 on page 3, is the following statement:

> "In the Lowe apparatus now in use the products of combustion pass from the generator at the top, down a flue, and enter the superheater at the bottom, where air is admitted to burn the gases to bring the superheater to a high temperature. By this it is readily seen that the gases produced in the generator were greatly cooled before they reached the superheater, and consequently about ten minutes elapses before the gases become sufficiently hot for combustion with the oxygen of the air blast, and frequently a red hot bar has to be inserted to ignite the gases; whereas with our construction, the connection between the superheater and the generator is made at the top, and is short, and the air to burn the gases produced in the generator for the purpose of heating the superheater is admitted by pipe O, just at the point where there is the greatest amount of heat, and so constant combustion is assured and loss of time obviated. Also, the superheaters, as usually constructed, are small in diameter and very high, and the gases pass upward through them quickly and without much effect, whereas by our construction of a superheater of large diameter and of the same height as the generator, and causing the gases to descend, they spread over the entire interior, and bring it to a high temperature in a very short space of time, and do their greatest work."

Upon the suggestion contained in the foregoing extract, the reissue patent was obtained. If shortening the pipe connecting the superheater and generator, as stated in the foregoing extract, is advantageous, then it is perfectly obvious that placing both chambers in the same structure would be an advantage. There is nothing in the original specification indicating that it was believed that the device therein described had any advantage over other devices, so far as avoiding loss of heat is con-

cerned. The new matter and the new claims in the reissue were an after-thought, in no wise connected with the process and device intended to be secured by the original patent.

3d. That the said Springer was guilty of laches in allowing more than four years to pass before attempting to correct any alleged errors or insufficiencies in the said original patent, No. 196,495, by appyling for a reissue thereof.

The original patent No. 196,495 was dated October 23, 1877, and the application for reissue was not filed until January 10, 1882. During this intervening time patent No. 248,070 was issued to B. Van Steenberg, dated October 11, 1881 (Rec., 155), and patent No. 234,400 was granted to A. O. Granger and J. H. Collins, Jr., dated November 16, 1880.

"Every independent inventor, every mechanic, every "citizen is affected by such delay, and by the issue of a "new patent with a broader and more comprehensive "claim. The granting of a reissue for such a purpose "after an unreasonable delay is clearly an abuse of the "power to grant reissues, and may justly be declared il-"legal and void.

"It will not do for the patentee to wait until other in-"ventors have produced new forms of improvement, and "then, with the new light thus acquired, under pretense "of inadvertence and mistake, apply for such enlarge-"ment of his claim as to make it embrace these new "forms. Such a process of expansion carried on in-"definitely, without regard to lapse of time, would oper-"ate most unjustly against the public, and is totally un-

" authorized by law. In such case, even, he who has " rights and sleeps on them justly loses them."

Miller v. *Brass Co.*, 104 U. S., 355.

And again in the same case it is stated: " But it must " be remembered that the claim of a specific device or " combination, and an omission to claim other devices or " combinations, apparent on the face of the patent, are, " in law, a dedication to the public of that which is not " claimed. It is a declaration that that which is not " claimed is either not the patentee's invention, or, if his, " he dedicated it to the public. This legal effect of the " patent can not be revoked unless the patentee surren- " ders it, and proves that the specification was framed by " real inadvertence, accident or mistake, without any " fraudulent or deceptive intention on his part, and this " should be done with all due diligence and speed. Any " unnecessary laches or delay in a matter thus apparent " on the record affects the right to alter or reissue the " patent for such cause. If two years' public enjoyment " of an invention without the consent and allowance of " the inventor is evidence of abandonment, and a bar to " an application for a patent, a public disclaimer in the " patent itself should be construed equally favorable to " the public. Nothing but a clear mistake or inadver- " tence, and a speedy application for its correction, is ad- " missible when it is sought merely to enlarge the " claim."

Miller v. *Brass Co.*, 104 U. S., 350.

See also:

Mahn v. *Harwood*, 112 U. S., 358.

Johnson v. *R. R. Co.*, 105 U. S., 539.

4th. That the apparatus erected by plaintiffs in error

is not an infringement of either the Lowe or Springer patents. By reference to the evidence of all the experts examined on the trial it will be seen that the manufacture of water gas as a fuel gas or enriched with hydrocarbons for illuminating purposes, is old, and these expert witnesses, examined on both sides, all agree that there is no substantial difference in the apparatus or processes claimed in said reissue patent by said Springer, and the apparatus and processes claimed by said T. S. C. Lowe, in his letters patent No. 167,847, issued more than two years previous to the issuing of the original patent to Theodore G. Springer; and the comparison of the claims added to the Springer patent in the reissue with the claims of the Lowe patent will show that there is no practical difference between the two; there is merely a difference in the verbiage of the claims.

By a reference to the drawings in the Lowe patent, heretofore cited, it will be seen that the fixing-chamber is in a separate structure, and the gases are conveyed from the top of the generator to the bottom of the fixing chamber by a pipe of considerable length. At the bottom of Lowe's fixing chamber there is a small chamber "g," above which is a perforated diaphragm or arch, which supports the refractory material of the fixing chamber.

By placing Lowe's fixing-chamber on the top of his generator, and dispensing with the long pipe connecting the two, and putting the fuel into the generator from the side instead of at the top, the Springer device is produced exactly in form as well as substance.

It is perfectly obvious to any one that the placing of the two chambers one above another would obviate the

loss of heat. In the patent issued to Granger & Collins, already quoted from, it appears that the long pipe connecting the two chambers in Lowe's apparatus was objectionable on account of the loss of heat, and they proposed to obviate it by shortening the pipe. Shortening the pipe and dispensing with the pipe are only degrees of the same thing; and if it could possibly be held that putting Lowe's fixing chamber above his generator would amount to an invention the suggestion in the Granger & Collins patent was what caused these claims to be asserted in the reissue. It is not invention to change the degree of a thing, or one feature of a thing.

Walker on Patents, 29.

In the case of *The United Gas Improvement Co.* v. *The New Haven Gas Light Co.*, 39 Fed. Rep., 268, the Lowe patent referred to was construed by Wallace, J., and it will be seen from that decision that the only patentable feature covered by the claims of the Lowe patent was the manner in which the fixing chamber or superheater was heated, by using a secondary blast to burn and cause complete combustion of the carbonic oxide carried off from the generator.

In Springer's reissue patent, the heat of the superheater, or fixing chamber, is provided for in precisely the same manner.

Now the difference between that class of an apparatus and the apparatus erected by plaintiff in error is that the gas is generated and fixed in one chamber of the apparatus of plaintiffs in error while there is a separate and distinct chamber for fixing the gas in the other.

The evidence shows that the arches into which the oil

is introduced in the apparatus erected by plaintiffs in error occupy only about one-fourth of the space over the fire, so that there is a large portion of the upper part of the cupola that is entirely open and unobstructed from the fire to the top, and the arches are used in the same way as retorts would be used to fix the oil vapors into gas.

These arches are heated by the direct heat of the fire, and while the secondary blast is sometimes used above the fire, the evidence shows that a large portion of the time the combustion is complete, and there is nothing whatever to burn with that blast, and it is not used; moreover the use of two thin fires instead of one deep fire, and the passing of the steam down through one fire and up through the other, is a very different process from using a single deep fire, where the upper part of the fuel is heated merely by contact with that part in which combustion is taking place, and not by actual combustion.

It is shown by the testimony of the witnesses called by the defendant in error that Alexander C. Humphreys is a first-class authority upon water gas and water gas apparatus (Rec., 57), and that he is now interested in and in the employ of the United Gas Improvement Company, the owner of both the Lowe and the Springer patents; and Mr. Humphreys, in an essay upon the subject published a few years ago by said company, distinctly states that there is a marked difference between the method of operation of the two kinds of apparatus.

The fact that the apparatus erected by plaintiffs in error might be cut in two, and one of the cupolas used

alone, does not make the apparatus, taken as a whole and operated in the manner it is intended to be operated, from being a very different apparatus with a very different mode of operation from both the Lowe and the Springer.

Conclusion.

In conclusion we respectfully submit that there is nothing in the record of this case which would warrant the conclusion that the jury would have found the issues for the defendant if the evidence touching the question of infringement had been excluded by the court.

"No court can correctly say that the merits of a case "have been fairly tried and determined where incom- "petent and, therefore, illegal evidence has been ad- "mitted upon such trial. The court can not say that the "illegal evidence had nothing to do in producing the "result."

Shearer v. *Harber*, 36 Ind., 540.

And as Mr. Justice Phillips, in the opinion filed in the Supreme court of Illinois, very truly says:

"The more important question, and the one chiefly "relied on by appellants for reversal, arises from the ad- "mission of evidence by the trial court tending to show "that the patent claimed by appellants for their ap- "paratus or machine was an infringement of a patent "controlled by the National Gas Light and Fuel Com- "pany." And it is very evident from the opinion of that court (Rec., 197) that the question of infringement is the paramount issue in this suit, and we respectfully submit

that for the errors assigned the judgment of the Supreme court of Illinois should be reversed and the cause remanded to the Circuit court of Edgar county, Illinois, for a new trial. All of which is

Respectfully submitted.

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